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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,779	02/03/2004	Neil S. Holland	002250-195	1023
21839	7590	11/03/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			KRAWCZEWCZ MYERS, LOUANNE C	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/769,779	HOLLAND, NEIL S.	
	Examiner	Art Unit	
	Louanne C Krawczewicz Myers	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on papers filed 2/3/04.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112 first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. Page 1, line 2, Applicant should delete "*hybrida*" and insert instead --*meyeri* X *Spiraea microphylla*-- as this recitation would be more botanically accurate.
- B. Page 2, after line 10 and before line 11, Applicant is requested to import into the specification a brief comparison between the instant plant and the parental cultivar(s), such need not be in any great detail, but should at least be to the extent necessary to positively distinguish the respective plants from each other.
- C. Page 2, line 13, U.S. Plant Patent Application No. 10/158,047 has matured into a U. S. Plant Patent. Applicant should delete "Application No. 10/158,047" and insert instead --No. 15,152--, if accurate.

D. Page 2, lines 14 and 15, at such time (if ever) that the copending application No. 10/365,435 of the specification matures into a United States Plant Patent, the specification should be amended to reflect same. If the copending application has been abandoned the specification should state such.

E. The statement bridging pages 2 and 3 of the specification should be amended to definitely state that the plant has been asexually propagated in firmly fixed form from one generation to another. The current recitation "capable of transmission" lends potential ambiguity to same. It is suggested that Applicant add the statement --The new cultivar reproduces true to type in successive generations of asexual reproduction.-- to the specification.

F. Page 5, lines 1-21, Applicant should import into the specification additional information relative to characteristic and observed foliage size (length and width), as well as foliage characteristics such as venation and sheen (if any), in the interest of providing as complete a botanical description of the plant as is reasonably possible.

G. At page 5, lines 15-21, the color designations set forth for the comparative cultivars should be reviewed for accuracy. In this regard, it is noted that the leaf color designation set forth in United Sates Plant Patent Number 12,294 is 137D,

not 138C (under surface). Correction to the specification and/or clarification is necessary.

- H. Page 6, lines 1-4, Applicant should set forth in the specification additional information relative to the instant plant's petioles including length and diameter.
- I. Page 6, lines 8-9, Applicant should set forth in the specification additional information with respect to characteristic an observed lenticel length and width.
- J. Page 6, line 11, it is not clear what is intended or encompassed by the recitation "Arrangement. -- Opposite." It would appear that this recitation is in error and should be deleted given that "Flower Arrangement" is set forth on page 6, line 17-20. Correction to the specification and/or clarification is necessary.
- K. Page 6, lines 12-16, Applicant should set forth in the specification additional information relative to the instant plant's flower buds including shape and number of buds per truss.
- L. Page 6, lines 17-20 and page 8, Applicant should set forth in the specification additional information relative to the instant plant's inflorescence with respect to

the typical and observed or number of blossoms/panicle as well as the age when the instant plant has been observed to first produce flowers.

M. Page 8, line 1, the recitation "Two per floret" is not understood. Did Applicant intend to state --flower-- instead of "floret"?

N. Page 8, line 6, Applicant should set forth in the specification whether the instant plant produces pollen. If the instant plant produces pollen then applicant should set forth the typical and observed amount of pollen produced, such as scarce, moderate or abundant, and its generic coloration. If no pollen is produced, applicant should simply state in the specification that no pollen is produced. Applicant should also set forth in the specification the pistil number.

O. Page 8, lines 18-20, to the extent that such has been systematically observed, information relative to the observed dates of flowering in the specified location(s) of culture should be set forth in the specification. Also, on page 8, line 20, Applicant should delete "has" and insert instead --have-- in order to be grammatically accurate.

P. Applicant should set forth in the specification information relative to the instant plant's seeds, if produced, including number of seeds, shape, length, diameter, and coloration.

Q. Page 11, lines 6-7 of the Abstract, Applicant states "made possible". This recitation does not appear to be appropriate. The recitation --The plant has good winter hardiness and-- appears to be more appropriate in this instance.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louanne C. Krawczewicz Myers whose telephone number is (571) 272-0979. The examiner can normally be reached on Monday and Thursday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone numbers for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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LKM

KENT BELL
PRIMARY EXAMINER

Kent T. Bell